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1624
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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 950.00)

Complete if Known

Application Number	10/083,842
Filing Date	february 27, 2002
First Named Inventor	Jonas Grina
Examiner Name	Deepak R. Rao
Art Unit	1624
Attorney Docket No.	50097A

METHOD OF PAYMENT (check all that apply)

Check Credit card Money Order Other None

Deposit Account:

Deposit Account Number 50-1744
Deposit Account Name Syngenta

The Director is authorized to: (check all that apply)

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FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity	Small Entity	Fee Description	Fee Paid
1051	130	2051 65 Surcharge - late filing fee or oath	
1052	50	2052 25 Surcharge - late provisional filing fee or cover sheet	
1053	130	1053 130 Non-English specification	
1812	2,520	1812 2,520 For filing a request for ex parte reexamination	
1804	920*	1804 920* Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805 1,840* Requesting publication of SIR after Examiner action	
1251	110	2251 55 Extension for reply within first month	
1252	420	2252 210 Extension for reply within second month	
1253	950	2253 475 Extension for reply within third month	
1254	1,480	2254 740 Extension for reply within fourth month	
1255	2,010	2255 1,005 Extension for reply within fifth month	
1401	330	2401 165 Notice of Appeal	
1402	330	2402 165 Filing a brief in support of an appeal	
1403	290	2403 145 Request for oral hearing	
1451	1,510	1451 1,510 Petition to institute a public use proceeding	
1452	110	2452 55 Petition to revive - unavoidable	
1453	1,330	2453 665 Petition to revive - unintentional	
1501	1,330	2501 665 Utility issue fee (or reissue)	
1502	480	2502 240 Design issue fee	
1503	640	2503 320 Plant issue fee	
1460	130	1460 130 Petitions to the Commissioner	
1807	50	1807 50 Processing fee under 37 CFR 1.17(q)	
1806	180	1806 180 Submission of Information Disclosure Stmt	
8021	40	8021 40 Recording each patent assignment per property (times number of properties)	
1809	770	2809 385 Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810 385 For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801 385 Request for Continued Examination (RCE)	
1802	900	1802 900 Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 950.00)

Large Entity	Small Entity	Fee Description
Fee Code (\$)	Fee Code (\$)	
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

**or number previously paid, if greater; For Reissues, see above

SUBMITTED BY		(Complete if applicable)		
Name (Print/Type)	Michael E. Yates	Registration No. (Attorney/Agent)	36,063	Telephone 919-541-8587
Signature	<i>Michael E. Yates</i>		Date	March 19, 2004

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

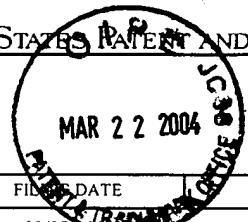
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→ M.Y.

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APPLICATION NO.	FILED DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,842	02/27/2003	Jonas Grina	1392/2/2	2780

22847 7590 09/29/2003

SYNGENTA BIOTECHNOLOGY, INC.
PATENT DEPARTMENT
3054 CORNWALLIS ROAD
P.O. BOX 12257
RESEARCH TRIANGLE PARK, NC 27709-2257

EXAMINER

RAO, DEEPAK R

ART UNIT	PAPER NUMBER
1624	11

DATE MAILED: 09/29/2003

Due: Dec. 29, 2003



Please find below and/or attached an Office communication concerning this application or proceeding.

MAR 22 2004

Office Action Summary

Application No.
10/083,842Applicant(s)
Grina

Examiner

Deepak Rao

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Sep 5, 20032a) This action is FINAL. 2b) This action is non-final.3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-28 are pending in the application.4a) Of the above, claim(s) 8-10 and 15-28 are withdrawn from consideration.5) Claim(s) _____ is/are allowed.6) Claim(s) 1-7 and 11-14 are rejected.7) Claim(s) _____ is/are objected to.8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).a) All b) Some* c) None of:1. Certified copies of the priority documents have been received.2. Certified copies of the priority documents have been received in Application No. _____.3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).a) The translation of the foreign language provisional application has been received.15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892).4) Interview Summary (PTO-413) Paper No(s). _____2) Notice of Draftsperson's Patent Drawing Review (PTO-948)5) Notice of Informal Patent Application (PTO-152)3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 86) Other: _____

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DETAILED ACTION

Claims 1-28 are pending in this application.

Election/Restriction

Applicant's election without traverse of Group I (claims 1-14) in Paper No. 10 is acknowledged.

Claims 15-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 10.

Applicant's election **without** traverse of the species of drawn to a compound of Formula I wherein:

R1 is C3-C8 branched chain alkyl;

R2 is unsubstituted phenyl;

R3 is unsubstituted pyridyl; and

R4 is hydrogen.

The elected species reads on claims 1-7 and 11-14

Applicant is reminded of the election of species guidelines provided in MPEP § 803.02, which are followed for examination. Portion from MPEP is provided here for convenience:

As an example, in the case of an application with a Markush-type claim drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD or CE. The Markush-type claim would then be examined fully with respect to the

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elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the non-elected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the merits on the elected claims would be final.

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

The elected species was not found in the prior art search and as per the guidelines above, the search was expanded to cover compounds of formula (I) for other values of **R1** and **R3**, while retaining the definitions of **R2** and **R4** as indicated above for the elected species, and art was found. As per the guidelines above, claims 8-10 drawn to compounds of formula II are additionally withdrawn from consideration pursuant to 37 CFR 1.142(b), as being drawn to non elected inventions.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-7 and 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

1. In claim 1, line 1, the phrase “A compound **comprising** ...” is open ended and is not permitted in a compound claim. ‘Comprising’ in a compound claim, leaves the claim open for the inclusion of unspecified groups and/or substituents. The use of the above phrase causes the claim to be broader than the invention. See *In re Fenton*, 451 F.2d 640, 171 USPQ 693 (CCPA 1971). Replacing the phrase with -- A compound of -- is suggested.
2. Claim 1 recites “A compound **and** the salts, stereoisomers, **and** tautomers thereof”, which is confusing because it is not clear if ‘a compound or the salt thereof’ is claimed or ‘a **mixture** of a compound and the salt, etc.’ is claimed. Replacing “and” with -- or -- is suggested.
3. In claim 1, it is recited that “R3 and O in Formula I to form a lactone ring” which is confusing. In formula I, the oxygen is doubly bonded and therefore has satisfied valency. It is not clear how R3 can form a ring with ‘O’. The specification does not provide any disclosure of such compounds.
4. Claim 3 recites the limitation "one of R2 and R3 is substituted with a substituent forming a cyclic structure on adjacent atoms of the aromatic ring" in lines 1-3. There is insufficient antecedent basis for this limitation in claim 1 on which claim 3 is dependent.

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The substituent list provided for the aromatic rings of R2 and R3 in claim 1 does not include any group to fit in the above recitation.

5. Claim 4 recites the limitation "wherein the substituent is selected from the group consisting of 1,2-methylenedioxy and 1,2-difluoromethylenedioxy" in lines 1-3. There is insufficient antecedent basis for this limitation in claim 1 on which claim 4 is dependent (via claim 3). The substituent list provided for the aromatic rings of R2 and R3 in claim 1 does not include any group to fit in the above recitation.
6. Claim 5 recites the limitation "3,4-methoxydioxyphenyl" under the definition of R2 in line 3. There is insufficient antecedent basis for this limitation in claim 1 on which claim 5 is dependent. The substituent list provided for the aromatic rings of R2 in claim 1 does not include a '3,4-methoxydioxy'. Further, it is not clear how this group is structurally presented.
7. In claim 7, the term "halo" is defined to include "fluoro, chloro.... and combinations thereof" which is confusing. It is not clear how one 'halo' group can include combinations such as fluoro and chloro, etc. The claim will be clear if amended to delete "and combinations thereof".

Claims not addressed above are included in the rejection because they are dependent claims and do not resolve the above issues.

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Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 6 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ajello et al. CAPLUS Abstract 71:80881. The instant claims read on the reference disclosed compound, see the compound having RN 23689-37-4.

Allowable Subject Matter

Claims 2-4, 7 and 12-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action, limited to the examined subgenus as indicated above and to include all of the limitations of the base claim and any intervening claims.

Receipt is acknowledged of the Information Disclosure Statement filed on March 3, 2003 and a copy is enclosed herewith.

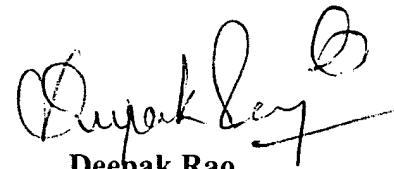
Art Unit: 1624

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (703) 305-1879. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (703) 308-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



Deepak Rao
Primary Examiner
Art Unit 1624

September 27, 2003

Notice of References Cited		Application/Control No.	Applicant(s)/Patent Under Reexam	
		10/083,842	Grina	
		Examiner	Art Unit	Page 1 of 1
		Deepak Rao	1624	

U.S. PATENT DOCUMENTS

	Document Number Country Code-Number-Kind Code	Date MM-YYYY ¹	Name	Classification ²
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FOREIGN PATENT DOCUMENTS

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P					
Q					
R					
S					
T					

NON-PATENT DOCUMENTS

	Include, as applicable: Author, Title, Date, Publisher, Edition or Volume, Pertinent Pages	
U	Ajello et al., CAPLUS Abstract 71:80881, 1969.	
V		
W		
X		

¹ A copy of this reference is not being furnished with this Office action. See MPEP § 707.05(a).

¹ Dates in MM-YYYY format are publication dates.

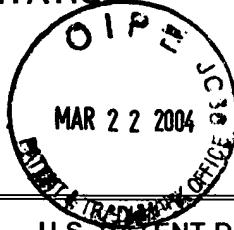
² Classifications may be U.S. or foreign.

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(REV. 7-85)U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

INFORMATION DISCLOSURE CITATION

ATTY. DOCKET NO.
50097USNP
APPLICATION NO.
10/083,842
APPLICANT
GRINA
FILING DATE:
February 27, 2002Confirmation No.
2780
Group
1638

1 Page several sheets if necessary



U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE
<i>JK</i>	A	5,880,333	3/9/99	GOFF	800	288	1/21/98
<i>JK</i>	B	6,504,082 B1	1/8/03	ALBERTSEN	800	278	9/10/99

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	OFFICE	CLASS	SUBCLASS	TRANSLATION YES NO
<i>JK</i>	C	EP 0 965 644 A2	12/22/99	EPO	C12N 15/82	15/85	<input type="checkbox"/> <input type="checkbox"/>
<i>JK</i>	D	WO 00/15791	3/23/00	WIPO	C12N 15/12	15/82	<input type="checkbox"/> <input type="checkbox"/>
<i>JK</i>	E	WO 93/03162	2/18/93	WIPO	C12 15/85	15/00	<input type="checkbox"/> <input type="checkbox"/>
<i>JK</i>	F	WO 96/37609	11/28/96	WIPO	C12N 15/12	15/85	<input type="checkbox"/> <input type="checkbox"/>
<i>JK</i>	G	WO 97/38117	10/16/97	WIPO	C12N 15/85	15/12	<input type="checkbox"/> <input type="checkbox"/>
<i>JK</i>	H	WO 99/02683	1/21/99	WIPO	C12N 15/12	15/86	<input type="checkbox"/> <input type="checkbox"/>
<i>JK</i>	I	WO 99/58155	11/18/99	WIPO	A61K 48/00	31/33	<input type="checkbox"/> <input type="checkbox"/>

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent pages, Etc.)

<i>JK</i>	J	Hoppe et al., <i>Adenovirus-Mediated Inducible Gene Expression in Vivo by a Hybrid Ecdysone Receptor Molecular Therapy</i> , Vol. 1, No. 2 (February 2000), pp. 159-164
<i>JK</i>	K	Koelle et al., <i>The Drosophila EcR Gene Encodes an Ecdysone Receptor, a New Member of the Steroid Receptor Superfamily</i> <i>Cell</i> , Vol. 67 (October 4, 1991), pp. 59-77
<i>JK</i>	L	Martinez et al., <i>Creation of ecdysone receptor chimeras in plants for controlled regulation of gene expression</i> <i>Molecular & General Genetics</i> , Vol. 261 (1999), pp. 546-552
<i>JK</i>	M	Martinez et al., <i>Ecdysone agonist inducible transcription in transgenic tobacco plants</i> <i>The Plant Journal</i> , Vol. 19(1) (1999), pp. 97-106
<i>JK</i>	N	Martinez et al., <i>Transcriptional activation of the cloned <i>Heliothis virescens</i> (Lepidoptera) ecdysone receptor (HvEcR) by Muristerone A</i> <i>Insect Biochemistry and Molecular Biology</i> , Vol. 29 (1999), pp. 915-930
<i>JK</i>	O	No et al., <i>Ecdysone-inducible gene expression in mammalian cells and transgenic mice</i> <i>Proceedings of the National Academy of Sciences USA</i> , Vol. 93 (April 1996), pp. 3346-3351
<i>JK</i>	P	Suhr et al., <i>High level transactivation by a modified <i>Bombyx</i> ecdysone receptor in mammalian cells without exogenous retinoid X receptor</i> <i>Proceedings of the National Academy of Sciences USA</i> , Vol. 95 (July 1998), pp. 7999-8004

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RECEIVED

EXAMINER	<i>Angela Negley</i>	DATE CONSIDERED	9/25/03
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*EXAMINER: Initial of reference considered, whether or not citation is in conformance with MPEP 609: Draw a line through citation if not in conformance and not considered. Include a copy of this form with the next communication to applicant.

Applicant's
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L17 ANSWER 8 OF 8 CAPLUS COPYRIGHT 2003 ACS on STN
 AN 1969:480881 CAPLUS
 DN 71:80881
 TI Reaction between phosphorus pentachloride and 3-isonitroso-2,4,5-triphenylpyrrole
 AU Ajello, Tommaso; Giannmanco, Lorenzo
 CS Ist. Chim. Farm. Tossicol., Univ. Palermo, Palermo, Italy
 SO Gazzetta Chimica Italiana (1969), 99(7), 690-9
 CODEN: GCITA9; ISSN: 0016-5603
 DT Journal
 LA Italian
 AB Treatment of 3-isonitroso-2,4,5-triphenylpyrrole (I) with PC15 (II) gave 1,2,4-triphenyl-1-cyano-4-chloro-3-azabuta-1,3-diene (III) (T. Aiello, 1940). III heated at 95.degree. in EtOH yielded HCl and .alpha.,.beta.-diphenyl-.beta.- (benzoylamino)propenonitrile (IV), which hydrolyzes to give .alpha.,.beta.-diphenyl-3-(benzoylamino)propenamide (V). V upon cyclization yields 2,5,6-triphenyl-4-(3H)-pyrimidone (VI). Thus, 0.5 g. III in 20 ml. EtOH was heated at 95.degree. 18-20 hrs. and cooled, to yield VI (V. Sprio, 1964), m. 310.degree. (EtOH). III (1.32 g.) suspended in 7 ml. EtOH was treated with NaOEt 48 hrs., and the mixt. worked up, to yield 1,2,4-triphenyl-1-cyano-4-ethoxy-3-azabuta-1,3-diene (VI), m. 90.degree. (ligroine) (IR data given). III in 20 ml. Me2CO was added to 1 g. NaOH in 20 ml. H2O, satd. with H2S, and stirred 12 hrs. to yield .alpha.,.beta.-diphenyl-.beta.- (thiobenzoylamino)propenonitrile (VII), m. 240.degree. (EtOH) (ir data given). VII boiled with aq. HCl and EtOH gave H2S and VI. III (1.4 g.) in 10 ml. Me2CO was mixed with 0.02 g. KOH and 10 ml. H2O and stirred at room temp. 2 hrs., to yield IV, m. 176.degree. (ligroine) (ir data given). IV upon hydrolysis with aq. HCl gave VI. IV (1 g.) in 20 ml. Me2CO was mixed with 4 ml. H2O + 1 ml. conc. HCl, the mixt. kept at 100.degree. 2 hrs., and worked up to yield V, m. 230.degree. (EtOH). V (0.5 g.) was added to 10 ml. Ac2O and the mixt. refluxed 20 hrs., cooled, dild. with H2O, and the ppt. collected, to yield triacetylated V (VIII), m. 210.degree. (EtOH). V upon treatment with either alkali or acids gave VI.
 IT 23689-37-4P
 RL: SPN (Synthetic preparation); PREP (Preparation)
 (prepn. of)
 RN 23689-37-4 CAPLUS
 CN Benzamide, N-(2-cyano-1,2-diphenylvinyl)- (8CI) (CA INDEX NAME)

